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09/837,094	04/18/2001	James M. Sheppard JR.	3129	8428

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT PAPER NUMBER

1771

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/837,094

Applicant(s)

SHEPPARD, JAMES M.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 5, 2003 has been entered.

### *Response to Amendment*

2. The Amendment submitted on December 5, 2003, has been entered. Claim 28 has been cancelled. Claim 21 has been amended. Therefore, the pending claims are 21 – 27.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21 – 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21 – 36 of copending Application No. 09/747,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because the jacquard loom recited in 09/747,529 and the

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dobby loom recited in this application can be used to produce the same simple fabric construction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

5. Claim 21 is objected to because of the following informalities: the phrase "shearing said side one side" is grammatically awkward. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 21 – 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Applicant fails to teach in the disclosure that the printed towel retains "its preprinted absorbency characteristics." While the disclosure does teach that the printed fabric is absorbent the disclosure does not compare the absorbency characteristics of the printed towel to the absorbency characteristics of the preprinted towel. Thus, this limitation is new matter.

### ***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 21 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson (4,259,994) in view of Carpenter et al. (5,983,952).

The reasons for rejection based on Hobson and Carpenter et al. have been set forth in the previous Office Action. The Applicant has added new limitations in the claim which were not previously addressed. Hobson discloses that the woven terry fabric can be formed into a velour fabric by cropping the fabric on one side. Cropping the fabric would produce the same structure as a sheared fabric. Further, the cropped yarns would inherently bloom to some degree since the yarns would natural open up or spread out when the yarn is cut and the internal tension in the yarn is released.

With respect to the limitation that the height of the sheared side in 75 to 95% of the height of the other side, Hobson discloses that the disclosed method results in less fiber waste, which can be very expensive, by producing less pile height variations (column 2, lines 39 – 45). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the claimed pile height, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). One of ordinary skill in the art would want to produce a pile height with the least amount of waste, which is expensive, as well as produce a luxurious, thick pile that is appealing to consumers.

The Applicant also claims that “a graphic impression can be applied thereto.” This limitation is not given any patentable weight since the claim only require that the fabric have the ability to have a graphic design printed on the surface. And, in the alternative, the fabric taught

by Hobson does have a graphic image on the surface of the fabric produced by the printed warp yarns. Therefore, the Hobson teaches the physical structure taught by the Applicant.

And finally, the Applicant recites that the towel retains its preprinted absorbency. Although Hobson and Carpenter et al. fail to discuss the preprinted absorbency of the printed fabric, it is reasonable to presume that said limitations would be met by the combination of the two references. Support for said presumption is found in the use of similar materials (i.e. terry cloth towel) and in the similar production steps (i.e. shearing one side of the terry cloth, applying a printed design to the towel surface) used to produce the printed towel. The burden is upon the Applicant to prove otherwise.

10. Claims 21 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherrill et al. (3,721,273) in view of Applicant's Admission (Specification, page 2).

Sherrill et al. discloses a woven terry cloth towel which exhibits a high sheen or brilliance and has a cut pile with a printed design on one side of the towel (abstract). The towel is soft and highly absorbent (column 1, lines 3 – 6). Sherrill et al. discloses that most terry fabrics are used as towels and are woven fabrics (column 1, lines 7 – 17). The towels are decorated by applying a printed pattern on the cut pile portion of the towel, producing a brilliant colored design (column 2, lines 5 – 15). The print penetrates into the pile so that the design area will have a soft hand (column 3, lines 53 – 58). As is shown in Figure 3, the cut pile height is relatively high as compared to the loop pile height. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the claimed pile height, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art, as set forth above. One of

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ordinary skill in the art would be motivated to produce a high a cut pile height as possible to produce a softer, thicker, and more absorbent product, to make the product more appealing to the customer.

Sherrill et al. fails to teach using two different colored warp yarns in the terry fabric. The Applicant discloses that it is well know to make terry cloth towels which are used as towels from dobby or cam loom machines (Specification, page 2). The Applicant also discloses that it is well known that dobby fabrics create thick, luxurious pile fabrics having a velour or looped terry structure and employs two different colors in the linear band of the warp filaments. Thus, it is well known to use woven terry cloth fabrics which have different color yarns as terry cloth towel fabrics. Therefore, it would have been obvious to one of ordinary skill in the art to use the multi-colored woven dobby terry cloth taught by the Applicant as the terry cloth towel in invention taught by Sherrill et al. since terry cloth towels made from dobby looms with different color yarns are well known types of terry cloth towels. Further, the Applicant also discloses that it is well known to print various design on terry cloth towels. Thus, a terry cloth fabric of any weave structure can be used in the invention taught by Sherrill et al. to produce a terry towel having enhanced brilliance.

Finally, not only does Sherrill et al. disclose that the printed designs can take the form of a plurality of design areas formed by screen printing (column 3, lines 45 – 52), but Figure 1 shows a printed towel that forms a pattern creating a border area that surrounds a central region. Further, with regards to the design limitations in the claims, i.e., the design of the printed matter, the location of the different color yarns used to create a colored design in the fabric, and the size and shape border and central region, it has been held by the court that matters relating to

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ornamentation only cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Hence, since Sherrill et al. in combination with the Applicant's Admission teaches the structural features of the claims, the claims are rejected.

### ***Response to Arguments***

11. Applicant's arguments filed December 5, 2003 have been fully considered but they are not persuasive. The Applicant argues that Hobson does not teach that the border is formed on all four edges and has the specific color scheme as recited in the claim. Hobson does teach a fabric produced on a dobby loom with a border region and different color yarns produce specific regions in the towel, distinguished by color. Thus, what the Applicant argues that Hobson doesn't teach is the specific design limitations, i.e., the first color yarns are located at the edges of fabric to form a border and the second color yarn forms a central region, while the colors are inversed on the opposite side of the fabric. However, it has been held by the court that matters relating to ornamentation only cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Hence, since Hobson teaches the structural elements, i.e., a woven fabric made from two different color yarns, which form distinct regions in the fabric, with a printed design on the finished product, then the pattern or design formed by the print layer and the color yarn does not make the product patentable over the prior art. The specific graphic image printed on the fabric, as well as the design formed by the different color yarns, produces no mechanical function whatever.

To further evidence that changing the design features in a towel by applying a printed graphic or creating a woven decorative design is well known and would be obvious to one



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having ordinary skill in the art, Carpenter et al. was used in the rejection. The background in Carpenter et al. discloses that it is known in the art to modify the weave design and apply various printed graphics to a woven fabric, produced on various looms including cam, dobby, and jacquard, to produce a decorative or aesthetic visible pattern (column 1, lines 15 – 35).

Carpenter et al. further teaches that fabrics have been produced which combine printed designs with woven designs (column 1, lines 36 – 39). Thus, based on the teachings in Carpenter et al., combining a weave design with a printed design is known in the art, and these designs or patterns can be modified to create an infinite number of combinations.

Additionally, even the Applicant admits in the background that it is well known to print designs onto terry cloth towels, and that these towels can be produced on dobby looms (Specification, page 2). And the Applicant further admits that the industry applies print on terry cloth fabrics to create an infinite number of patterns, colors, and messages to keep production costs low. (Specification, page 2). Hence, even the Applicant recognizes that there are an infinite number of designs which can be printed on terry cloth towels to produce a colorful towel at lower production costs, and it is well known in the industry to change or vary those designs base on the desired end product. Therefore, it would have been obvious to one of ordinary skill in the art to modify the design elements, i.e., the weave structure and the printed graphic design, in the towel taught by Hobson, to produce an infinite number patterns and designs. Thus, the rejection is maintained.

Additionally, the Applicant argues that it is not proper to combine Hobson with the teachings of Carpenter et al. because Hobson is drawn to dobby weaving and Carpenter et al. is drawn to jacquard weaving. However, the part of the reference relied on in Carpenter et al. was

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the background which discussed the weaving art in general and does specifically mention fabrics produced on dobby looms. Hence, since the background provides a discussion of the general knowledge and skill in the weaving art it is directly analogous to the woven fabric taught by Hobson, even though the majority of the patent is drawn to another type of weaving machine. Finally, not only is Carpenter et al. analogous since this section discusses the weaving art in general, which is the Applicant's field of endeavor, but the reference is also analogous because it is reasonably pertinent to the Applicant's particular problem, i.e., creating printed woven fabric.

Further, the Applicant mentions that "there is no way one skilled in the art can modify Hobson or Carpenter and place a "border" on all edge without totally ignoring the teachings of these references" (Response, page 5). Since the Applicant provided no further arguments in support of this statement it is unclear how either of these references teach away from having a border on all four sides of the fabric. Both dobby looms and jacquard looms can be used to produce a border on all four edges if so desired. In fact Hobson and Carpenter et al. clearly teach that the product should have a border on at least two side. And while they do not explicitly teach a border on all four edges they in no way exclude having a border on the finished edges. Thus, this feature is a design feature which can be readily changed based on the demands of the consumer and the current fashion trends. Thus, the Applicant's argument is not sufficient since there is no evidence to support it.

Finally, it is noted that the Applicant also argues that the objects of the invention are achieved by utilizing a color scheme in combination with a printed design (Response page 6). This further proves that the features which the Applicant relies on to distinguish over the prior art are actually design features and not structural limitations. The design features only effect the

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appearance of the finished product and in no way produce a mechanical function. Therefore, the rejections are maintained since ornamentation only cannot be relied upon to patentably distinguish the claimed invention from the prior art.

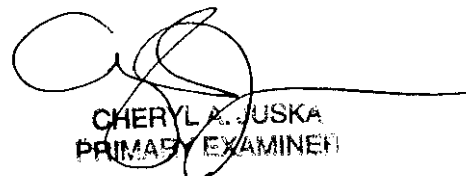
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jenna-Leigh Befumo  
February 6, 2004



CHERYL A. JUSKA  
PRIMARY EXAMINER